

## **REMARKS/ARGUMENTS**

### **I. Summary of the Office Action**

In the Office Action claims 1-23, 30-51 and 72-97 are pending. Claims 1-23, 30-51, and 72-92 are rejected.

The Examiner rejected claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, 45-49, 73-75, 78-80, 83-85, 87, 89-91 and 94-97 under 35 U.S.C. 103(a) as being anticipated by Hoffman U.S. Patent 4,988,255 (hereinafter "Hoffman") in view of Peres U.S. Patent 3,739,471 (hereinafter "Peres"). The Examiner rejected claims 4-6, 33, 44, 72, 77, 82, and 88-89 under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 3, 32, 43, 1, 30, 37 above, and in further view of McGrath *et al.* U.S. Patent 6,494,017 (hereinafter "McGrath"). The Examiner rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 1 above, and further in view of Blaimschein U.S. Patent 5,318,420 (hereinafter "Blaimschein"). The Examiner rejected 17-18, 35, 50, 76, 81, 86, and 92 under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1, 30, 37, and 87 above, and further in view of Kitamura *et al.* U.S. Patent 5,423,216 (hereinafter "Kitamura"). The Examiner rejected claims 21-23, 36, and 51 under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1, 30 and 37 above, and further in view of Yuyama *et al.* U.S. Patent 6,644,504 (hereinafter "Yuyama"). The Examiner rejected claims 40-42 under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 37, and further in view of Coughlin U.S. Patent Application 2004/0059463 (hereinafter "Coughlin"). The Examiner rejected claim 93 under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Peres, McGrath, Blaimschein and in view of Kitamura.

## **II. Summary of Applicants Reply**

Applicants respectfully submit that no new matter has been introduced into the subject application. Amendments to and cancellations of the claims are being made solely to expedite prosecution, and do not constitute acquiescence to any of the Examiner's objections to or rejections of the claims. Specifically, new claims 98-105 are supported by the original specification and drawings, for example, as discussed below in greater detail.

The Examiner's rejections are respectfully traversed below.

Reconsideration of the present application is respectfully requested.

## **III. The Rejection of Claims under 103(a): Hoffman In View Of Peres**

In rejected all claims the Examiner relied on Hoffman in view of Peres. The Examiner admitted that:

Hoffman does not disclose to cut at least one of the top, sidewall or bottom of the container. However, Peres disclose that it is well known in the art of emptying the containers to cut the top (95) of the container (see col. 4, lines 38-55) to empty the container.  
(Office Action, page 2)

Applicant disagrees that there is motivation to combine Hoffman and Peres.

MPEP §2145(X)(D)(2) entitled "References Cannot Be Combined Where Reference Teaches Away from Their Combination" recites "It is improper to combine references where the references teach away from their combination." See re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Hoffman teaches away from, at least, destroying the bottle reciting:

U.S. Pat. No. 4,573,852 discloses an apparatus for rupturing a plastic bottle or vessel in order to recover their contents. This apparatus comprises a rupturing member, means for locating a bottle or vessel to

be ruptured, means for limiting the movement of the bottle or vessel and means for moving the limiting means and the rupturing member relative to one another whereby to rupture the bottle or vessel. **However, this apparatus has the drawbacks that the bottle or vessel is destroyed and there is a high probability that the pharmaceutical product will be contaminated by bits of the ruptured container.**

(Hoffman, background.)

That is, Hoffman teaches away from destroying the bottle (e.g., cutting) and is, at least, concerned with contaminating the pharmaceutical. Unlike Hoffman that teaches away from, at least, destroying the bottle and contaminating the pharmaceutical, Peres discloses severing of container tops an action that would, at least, destroy the bottle. Hoffman specifically teaches away from destroying the bottle (e.g., cutting, rupturing, and severing) reciting that “**However, this apparatus has the drawbacks that the bottle or vessel is destroyed and there is a high probability that the pharmaceutical product will be contaminated by bits of the ruptured container.**” Accordingly, Hoffman teaches away from Peres.

Further, Applicants respectfully traverse the Examiner’s statement “that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the seal cutter of Hoffman with the top cutter of Peres to cut the top of the container to empty the container.” Applicant requests that the Examiner provide supporting references and/or an affidavit under 37 C.F.R. § 1.104(d)(2). In the absence of either, Applicants request withdrawal of rejections made, in part, based on the Notices.

#### IV. New Claims

Applicants respectfully submit new claims 98-105. Further applicants submit that no new subject matter is added by these claims as they are supported by the application.

### **CONCLUSION**

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

Applicants also traverse any "Official Notice," "Design Choice," "Admitted Prior Art" or other alleged prior art that the Examiner purports is well known with respect to the claimed combination of the present invention. Applicants disagree and request the Examiner to provide a prior art reference describing any of these features that the Examiner has not provided a prior art reference or an affidavit under 37 C.F.R. Section 1.104(d)(2) providing details of why it would have been obvious. In the absence of either, Applicants request withdrawal of this rejection for these reasons as well.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

/Irah H. Donner/

Irah H. Donner  
Registration No. 35,120

Wilmer Cutler Pickering Hale and Dorr LLP  
399 Park Avenue  
New York, NY 10022  
TEL (212) 230-8887  
FAX (212) 230-8888

Date: October 30, 2007

IHD/DRW/tes